IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Lester K. Chu et al.

Application No.: 10/800,444   Confirmation No.: 1779

Filed: March 15, 2004   Art Unit: 3625

For: INFORMATION DISTRIBUTION SYSTEM   Examiner: N. D. Rosen
      AND METHOD THAT ORGANIZES
      LISTINGS USING TIERS

SUPPLEMENTAL APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Supplemental Appeal Brief is responsive to the Notification of Non-Compliant Appeal Brief dated October 29, 2007, requesting that modifications be made such that the brief contain a "Related Proceedings" section. This Supplemental Appeal Brief includes a "Related Proceedings" section as required, and replaces the Appeal Brief filed October 5, 2007.

This appeal is from the decision of the Primary Examiner dated May 9, 2007 ("Final Office Action"), finally rejecting claims 1 - 56, which are reproduced as an Appendix to this brief. The Notice of Appeal was filed on August 7, 2007. This application was filed on March 15, 2004.

TABLE OF CONTENTS

I. **REAL PARTY IN INTEREST**

The real party in interest is Idearc Media Corp., Assignee, a corporation organized and existing under the laws of the state of Delaware, and having a place of business at 2200 W. Airfield Dr., P.O. Box 619810, DFW Airport, Texas, 75261-9810.

II. **RELATED APPEALS AND INTERFERENCES**

Applicant (hereinafter "Appellant") is not aware of any related appeals or interferences that would affect the Board's decision on the current appeal.

III. STATUS OF CLAIMS

Claims 1-56 are pending and are the subject of this appeal. Claims 1, 38, 48, and 49 are independent claims. Each of claims 1-56 is reproduced in an Appendix to this Appeal Brief.

In the Final Office Action, claims 1, 4-6, 10, 13, 14, 17, 18, 22, 23, 26, 27, 31, 36, and 48 were rejected under 35 USC § 103(a) as allegedly unpatentable over United States Patent No. 7,110,993 ("Soulanille") in view of United States Patent No. 6,801,906 ("Bates"). Claims 2 and 3 were rejected under 35 USC § 103(a) as allegedly unpatentable over the combination of Soulanille and Bates further in view of an article by Weidlich entitled "Search Engine Marketing Revving Up." Claims 7-9, 11, 12, 15, 19, and 37 were rejected under 35 USC § 103(a) as allegedly unpatentable over the combination of Soulanille and Bates further in view of United States Patent Application Publication No. 2003/0177076 ("Might"). Claims 16 and 24 were rejected under 35 USC § 103(a) as allegedly unpatentable over the combination of Soulanille and Bates further in view of United States Patent Application Publication No. 2004/0167845 ("Corn"). Claims 20 and 21 were rejected under 35 USC § 103(a) as allegedly unpatentable over the combination of Soulanille and Bates further in view of United States Patent No. 6,564,208 ("Littlefield"). Claim 25 was rejected under 35 USC § 103(a) as allegedly unpatentable over the combination of Soulanille and Bates further in view of United States Patent Application Publication No. 2006/0190328 ("Singh"). Claims 28 and 29 were rejected under 35 USC § 103(a) as allegedly unpatentable over the combination of Soulanille and Bates further in view of Official Notice. Claim 30 was rejected under 35 USC § 103(a) as allegedly unpatentable over the combination of Soulanille and Bates further in view of United States Patent Application Publication No. 2001/0003177 ("Schena"). Claim 32 was rejected under 35 USC § 103(a) as allegedly unpatentable over the combination of Soulanille and Bates further in view of United States Patent Application Publication No. 2004/0186769 ("Mangold"). Claim 32 was also rejected under 35 USC § 103(a) as allegedly unpatentable over the combination of Soulanille and Bates further in view of United States Patent Application Publication No. 2002/0010015 ("Acres"). Claim 33 was rejected under 35 USC § 103(a) as allegedly unpatentable over the combination of Soulanille and Bates further in view of Mangold and further in view of an article by Mahanta et. al entitled "BT dotcom." Claim 33 was also rejected under 35 USC § 103(a) as

allegedly unpatentable over the combination of Soulanille, Bates, and Acres, further in view of Mahanta. Claims 34 and 35 were rejected under 35 USC § 103(a) as allegedly unpatentable over the combination of Soulanille and Bates further in view of Acres. Claims 38-42 and 44-46 were rejected under 35 USC § 103(a) as allegedly unpatentable over Soulanille and the anonymous article "Google Comes Out Ahead," and further in view of Bates. Claim 43 was rejected under 35 USC § 103(a) as allegedly unpatentable over Soulanille and the anonymous article "Google Comes Out Ahead," further in view of Bates, and further in view of Might. Claim 47 was rejected under 35 USC § 103(a) as allegedly unpatentable over Soulanille and the anonymous article "Google Comes Out Ahead," further in view of Bates, and further in view of Littlefield. Claims 49 and 52-56 were rejected under 35 USC § 103(a) as allegedly unpatentable over Soulanille in view of United States Patent Application Publication No. 2003/0093482 ("Watanabe") and Bates. Claim 50 was rejected under 35 USC § 103(a) as allegedly unpatentable over Soulanille, Watanabe, and Bates, and further in view of Official Notice. Claim 51 was rejected under 35 USC § 103(a) as allegedly unpatentable over Soulanille, Watanabe, and Bates, and further in view of Might.

IV. STATUS OF AMENDMENTS

In their Response After Final Action dated July 17, 2007, Appellants did not submit, and the Examiner did not enter, any amendments to the application subsequent to final rejection. Accordingly, claims 1-56 being appealed herein are pending as listed in Appellant's Response to Final Office Action dated May 9, 2007.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The following is a concise explanation of the subject matter defined in each of the claims involved in the appeal, as required by 37 C.F.R. § 41.37(c)(1)(v). In general, the following explanation is not intended to be used to construe the claims, which are believed to speak for themselves, nor does Appellant intend the following explanation to modify or add any claim elements, or to constitute a disclaimer of any equivalents to which the claims would otherwise be entitled, nor is any discussion of certain preferred embodiments herein intended to disclaim other possible embodiments. References herein to the Specification are intended to be exemplary and not limiting.

A.   Claim 1

Claim 1 recites an information distribution system, comprising a user subsystem, said user subsystem providing for a request from a user and a response; wherein said user subsystem provides for receiving said request and providing said response. For example, with regard to Appellants' Figures 1 and 8a, Figure 8a is a block diagram illustrating one example of a subsystem-level view of the system 100 that includes a user subsystem 310 and a sponsor subsystem 312. (Specification, page 63, lines 29-31.) Further, a user subsystem 310 can be used by users 130 to submit requests 132 and receive responses 144. (Specification, page 64, lines 1-2.)

Claim 1 further comprises a listing subsystem, said listing subsystem providing for a plurality of listings, wherein at least a subset of said listings are included in said response. For example, the listing subsystem 318 makes the various listings 104 stored in the database structure 126 accessible to the interface subsystem 316 in accordance with the administrative rules 122. (Specification, page 65, lines 30-32.)

Claim 1 further comprises a plurality of groups, wherein each said listing in said response is associated with at least one said group, each said group being determined at least in part according to said request. For example, it would typically be desirable to facilitate the organization of various provider listings into "groups" based on geography, category, fee type (such as fixed fee approaches or bid-based approaches), and other distinctions. (Specification, page 7, lines 18-21.)

8

Claim 1 further comprises an administrative subsystem, said administrative subsystem providing for a tier, wherein said administrative subsystem selectively identifies two or more listings within said response for inclusion in said tier, wherein said listings within said tier are ordered in accordance with at least one of: (a) a random heuristic; (b) a weighted random heuristic; and (c) a placement heuristic not applied to all of the listings in said response. For example, the administrative subsystem 306 is the mechanism by which administrative rules 122 are created, configured, updated, and deleted within the system 100. (Specification, page 63, lines 20-21.) Further, the ordering of the listings within their identified tiers is performed in accordance with the predefined rules of the system. In some embodiments, ordering listings within the tiers is a purely random function. In other embodiments, the probability can be modified or weighted by some other metric, such as the metric used to organize the listings into tiers in the first place, or some other metric. (Specification, page 14, lines 17-22.)

B.   Claim 2

Claim 2 depends from claim 1. Claim 2 further comprises a plurality of priority metrics, wherein said administrative subsystem uses at least some of said priority metrics to selectively identify said listings for inclusion in said tier. For example, with regard to Appellants' Figures 1 and 2, a priority metric 179 can be used by the placement heuristic 174 to identify the desired order of various listings 104. The inputs for the calculation of the priority metric 179 can include virtually any of the listing attributes 106 and request attributes 134 relating to the listing 104. (Specification, page 42, lines 26-29.) Further, with regard to Appellants' Figures 1 and 2, in some embodiments, the priority metric 179 is calculated from the type fees 112 paid by the particular advertiser 102 and a position adjustment factor 176 to incorporate the broader relationship between the administrator 160 and the advertiser 102. In those embodiments, listings 104 are organized into various groups on the basis of category attributes 110, geography attributes 108, and fee type attributes 112. (Specification, page 42, line 30-page 43, line 1.)

C.   Claim 10

Claim 10 depends from claim 1. Claim 10 recites that said listings belonging to said tier belong to the same said group. For example, listing groups can be dynamically defined by the interactions between listing attributes set forth by the provider, the request attributes set forth by

the customer, and/or the administrative rules implemented by the administrator for the system. Each group in a response can have its own methodology for ordering the listings within the group. The listings need not be displayed in a manner that is determined in a sort by group. (Specification, page 12, line 31-page 13, line 2.) Further, whatever the basis for "competition" between listings (e.g. per-hit fees, relevancy metric, etc.), the impact of the competition in a system utilizing tiers-based processing is to place listings within various tiers. The size of the tiers can vary widely from embodiment to embodiment. (Specification, page 14, lines 14-17.)

D.   Claim 17

Claim 17 depends from claim 1. Claim 17 further comprises a plurality of responses, said plurality of responses including a first response and a second response, wherein said first response includes said tier and wherein said second response does not include said tier. For example, listing groups can be dynamically defined by the interactions between listing attributes set forth by the provider, the request attributes set forth by the customer, and/or the administrative rules implemented by the administrator for the system. Each group in a response can have its own methodology for ordering the listings within the group. The listings need not be displayed in a manner that is determined in a sort by group. (Specification, page 12, line 31-page 13, line 2.) Further, whatever the basis for "competition" between listings (e.g. per-hit fees, relevancy metric, etc.), the impact of the competition in a system utilizing tiers-based processing is to place listings within various tiers. The size of the tiers can vary widely from embodiment to embodiment. (Specification, page 14, lines 14-17.)

E.   Claim 27

Claim 27 depends from claim 26, which depends from claim 1. Claim 27 further recites wherein said tier includes three said listings. For example, in a competition based on a per-hit fee for tiers of three listings each, entry into the first tier would require that a particular listing out compete all but the top two listings. (Specification, page 14, lines 24-26.)

F.   Claim 28

Claim 28 depends from claim 1. Claim 28 further comprises a plurality of tiers, a plurality of responses, a plurality of requests, and a plurality of tier processing rules, wherein a number of said tiers and said tier processing rules differ for different said requests. For example,

listing groups can be dynamically defined by the interactions between listing attributes set forth by the provider, the request attributes set forth by the customer, and/or the administrative rules implemented by the administrator for the system. Each group in a response can have its own methodology for ordering the listings within the group. The listings need not be displayed in a manner that is determined in a sort by group. (Specification, page 12, line 31-page 13, line 2.) Further, whatever the basis for "competition" between listings (e.g. per-hit fees, relevancy metric, etc.), the impact of the competition in a system utilizing tiers-based processing is to place listings within various tiers. The size of the tiers can vary widely from embodiment to embodiment. (Specification, page 14, lines 14-17.)

G.   Claim 33

Claim 33 depends from claim 32, which depends from claim 31, which depends from claim 1. Claim 33 further comprises a number of hits and a period of time in which to measure said number of hits, wherein said number of hits and said period of time influence said variable per-hit fee. For example, in some embodiments of the system, the per-hit fee associated with a particular listing can be increased or decreased in accordance with the popularity of the listing. For example, in a step function approach, the system can be configured so that after 500 hits during a particular period of time, the per-hit fee associated with the particular listing is increased or decreased in accordance with some value, ratio, or factor. (Specification, page 15, lines 12-17.)

H.   Claim 34

Claim 34 depends from claim 1. Claim 34 further comprises a plurality of per-hit fee types. For example, the system 100 can be flexibly configured to support a wide range of different "hit" based functionality. The system 100 can support many different kinds of "hits." In a first example, each time a listing 104 is included in a response 144 could be considered a "view hit." In a second example, each time a listing 104 results in a sending of an e-mail through the system 100 could be considered an "e-mail hit." In a third example, each time a user 130 invokes an automated calling feature could be referred to as a "call hit." In a further example, each time a user 130 invokes a web link to an advertiser's 102 web site through a listing 104 could be considered a "web hit." In another example, each time a user invokes an

information request to a particular listing 104 could be considered an "information" hit. In a final illustrative example, each time a user 130 invokes a map relating to a particular listing 104 could be considered a "map hit." (Specification, page 27, lines 14-25.) Further, every potential interaction between the user 130 and the listing 104 can potentially constitute a particular type of "hit" that is distinguished by the system 100. A single embodiment of the system 100 can include a wide variety of different kinds of hits. Each type of hit can result in a different per-hit fee 113. (Specification, page 27, line 31-page 28, line 1.)

I.   Claim 35

Claim 35 depends from claim 34, which depends from claim 1. Claim 35 further recites that said plurality of listings includes a first listing, wherein said first listing is associated with more than one said per-hit fee type. For example, the system 100 can be flexibly configured to support a wide range of different "hit" based functionality. The system 100 can support many different kinds of "hits." In a first example, each time a listing 104 is included in a response 144 could be considered a "view hit." In a second example, each time a listing 104 results in a sending of an e-mail through the system 100 could be considered an "e-mail hit." In a third example, each time a user 130 invokes an automated calling feature could be referred to as a "call hit." In a further example, each time a user 130 invokes a web link to an advertiser's 102 web site through a listing 104 could be considered a "web hit." In another example, each time a user invokes an information request to a particular listing 104 could be considered an "information" hit. In a final illustrative example, each time a user 130 invokes a map relating to a particular listing 104 could be considered a "map hit." (Specification, page 27, lines 14-25.) Further, every potential interaction between the user 130 and the listing 104 can potentially constitute a particular type of "hit" that is distinguished by the system 100. A single embodiment of the system 100 can include a wide variety of different kinds of hits. Each type of hit can result in a different per-hit fee 113. (Specification, page 27, line 31-page 28, line 1.)

J.   Claim 38

Claim 38 recites a system for distributing information, comprising a depository of information, said depository of information including a plurality of listings. For example, with reference to Appellants' Figure 1, the listings 104 and listing attributes 106 provided to the

system 100 by the advertiser 102 are stored, updated, processed, and accessed in the form of a variety of listing records 128 that reside within the database structure 126. (Specification, page 30, lines 26-28.)

Claim 38 further recites a server, said server including a request from a user, a response, and a plurality of administrative rules, said plurality of administrative rules including a plurality of placement heuristics. For example, with regard to Appellant's Figure 1, the server 118 can be any device or configuration of devices capable of receiving information from one or more interfaces, and housing a set of instructions 120 needed to provide the functionality of the system 100. (Specification, page 29, lines 22-24.) Further, although only one user 130 is displayed in the Figure, it is anticipated that millions of different users 130 could submit requests 132 and receive responses 144 using the system 100. (Specification, page 32, lines 5-7.) Further, the administrative rules 122 that make up the system 100 can take on a wide variety of forms. Each embodiment of the system 100 can involve different types and combinations of administrative rules 122. (Specification, page 39, lines 19-21.) Further, with reference to Appellants' Figure 2, the response heuristic 172 is the process performed by the system 100 to populate the response 144. (Specification, page 41, lines 18-19.) Further, still with reference to Appellants' Figure 2, as identified by the bracket originating from the response heuristic 172 and encompassing the placement heuristic 174, the placement heuristic 174 is a sub-process that is part of the response heuristic 172. (Specification, page 42, lines 4-6.)

Claim 38 further recites that said server is configured to generate said response from said request by accessing said depository of information and said administrative rules. For example, a user subsystem 310 can be used by users 130 to submit requests 132 and receive responses 144. (Specification, page 64, lines 1-2.)

Claim 38 further recites that said administrative rules provide for ordering said listings included in said response. For example, listing groups can be dynamically defined by the interactions between listing attributes set forth by the provider, the request attributes set forth by the customer, and/or the administrative rules implemented by the administrator for the system. Each group in a response can have its own methodology for ordering the listings within the group. (Specification, page 12, line 31-page 13, line 1.) Further, the ordering of the listings

within their identified tiers is performed in accordance with the predefined rules of the system. (Specification, page 14, lines 17-18.) Further, Administrators configure the processing performed by the system by the creation and updating of administrative rules that determine which listings are selected by the system in response to a particular request, and how those listings are ordered and otherwise displayed in the response sent back the originator of the request. (Specification, page 21, lines 4-8.)

Claim 38 further recites that said administrative rules provide for identifying two or more listings in said response as belonging to a tier identified from a plurality of tiers. For example, in some embodiments of the system, listings are first organized into tiers before the position of a particular listing within a particular tier is determined. The position of listings within a particular tier can be determined by different placement heuristics than used for other tiers within a single response to a single request. (Specification, page 22, lines 21-24.) Further, the size of the tiers can vary widely from embodiment to embodiment. (Specification, page 22, lines 33-34.)

Claim 38 further recites that said administrative rules prioritize said listings within said of tiers using said plurality of placement heuristics. For example, in some embodiments of the system, listings are first organized into tiers before the position of a particular listing within a particular tier is determined. The position of listings within a particular tier can be determined by different placement heuristics than used for other tiers within a single response to a single request. (Specification, page 22, lines 21-24.)

Claim 38 further recites that said administrative rules provide for generating a plurality of groups, wherein each said listing in said response is associated with at least one said group, each said group being determined at least in part according to said request. For example, a single response can include more than one group of listings. Listing groups can be dynamically defined by the interactions between listing attributes set forth by the provider, the request attributes set forth by the customer, and/or the administrative rules implemented by the administrator for the system. Each group in a response can have its own methodology for ordering the listings within the group. The listings need not be displayed in a manner that is determined in a sort by group. (Specification, page 12, line 30-page 13, line 2.)

14

K.   Claim 45

Claim 45 depends from claim 40, which depends from claim 38. Claim 45 further comprises a first listing and a second listing, wherein a priority metric associated with said first listing is higher than a priority metric associated with said second listing, and wherein said second listing is given a more favorable placement than said first listing. For example, administrators configure the processing performed by the system by the creation and updating of administrative rules that determine which listings are selected by the system in response to a particular request, and how those listings are ordered and otherwise displayed in the response sent back the originator of the request.   The administrative rules can determine the fees of certain advertisements, and such fees can include fixed-fees as well as various per-hit fees. The order in which listings are displayed in a particular response to a particular request can be influenced by numerous variables or combinations thereof, including a group affiliation, a geography attribute, a category attribute, a priority metric, a fixed-fee, a per-hit fee, a position adjustment factor, and an enhanced display fee. In many embodiments, the ordering and positioning of lists are not dependent on any single input variable. (Specification, page 21, lines 4-15.)

L.   Claim 46

Claim 46 depends from claim 38. Claim 46 further comprises a first listing and a second listing and a plurality of per-hit fees, wherein each said listing in said response is associated with at least one said per-hit fee, wherein said per-hit fee associated with said first listing is higher than said per-hit fee associated with said second listing, and wherein said second listing is given a more favorable placement than said first listing. For example, in some embodiments, the relationship between users and advertisers can also be associated with a position adjustment factor that impacts the priority metrics associated with various listings. For example, the popularity of a particular listing can enhance the priority metric for that particular listing so that the priority metric for that particularly listing surpasses the priority metrics associated with listings involving higher per-hit fees. (Specification, page 13, lines 22-27.)

M.   Claim 48

Claim 48 recites an information distribution system, comprising a user subsystem, said user subsystem providing for a request from a user and a response, wherein said user subsystem provides for receiving said request and providing said response. For example, with regard to Appellants' Figures 1 and 8a, Figure 8a is a block diagram illustrating one example of a subsystem-level view of the system 100 that includes a user subsystem 310 and a sponsor subsystem 312. (Specification, page 63, lines 29-31.) Further, a user subsystem 310 can be used by users 130 to submit requests 132 and receive responses 144. (Specification, page 64, lines 1-2.)

Claim 48 further comprises a listing subsystem, said listing subsystem providing for a plurality of listings, wherein at least a subset of said listings are included in said response. For example, the listing subsystem 318 makes the various listings 104 stored in the database structure 126 accessible to the interface subsystem 316 in accordance with the administrative rules 122. (Specification, page 65, lines 30-32.)

Claim 48 further comprises an administrative subsystem, said administrative subsystem providing for a plurality of tiers, wherein said administrative subsystem selectively identifies two or more listings within said response for inclusion in one of said tiers, wherein said listings within said one of said tiers are ordered in accordance with at least one of: (a) a random heuristic; (b) a weighted random heuristic; and (c) a placement heuristic. For example, the administrative subsystem 306 is the mechanism by which administrative rules 122 are created, configured, updated, and deleted within the system 100. (Specification, page 63, lines 20-21). Further, the ordering of the listings within their identified tiers is performed in accordance with the predefined rules of the system. In some embodiments, ordering listings within the tiers is a purely random function. In other embodiments, the probability can be modified or weighted by some other metric, such as the metric used to organize the listings into tiers in the first place, or some other metric. (Specification, page 14, lines 17-22.)

Claim 48 further comprises that said administrative subsystem further providing for generating a plurality of groups, wherein each said listing in said response is associated with at least one said group, each said group being determined at least in part according to said request.

For example, a single response can include more than one group of listings. Listing groups can be dynamically defined by the interactions between listing attributes set forth by the provider, the request attributes set forth by the customer, and/or the administrative rules implemented by the administrator for the system. Each group in a response can have its own methodology for ordering the listings within the group. The listings need not be displayed in a manner that is determined in a sort by group. (Specification, page 12 line 30-page 13, line 2.)

N.   Claim 49

Claim 49 recites a method for displaying a response to a request, comprising configuring a plurality of administrative rules to organize a plurality of listings within a response into at least one tier based on a plurality of tier criteria, wherein said administrative rules include a tier placement heuristic for ordering listings within the tier, wherein not all listings within the response belong to the tier. For example, administrators configure the processing performed by the system by the creation and updating of administrative rules that determine which listings are selected by the system in response to a particular request, and how those listings are ordered and otherwise displayed in the response sent back the originator of the request. (Specification, page 21, lines 4-8.) Further, a tier placement heuristic is a placement heuristic 174 that is specific to one or more tiers 169. (Specification, page 42, lines 20-21.) Further, in some embodiments of the system, listings are first organized into tiers before the position of a particular listing within a particular tier is determined. The position of listings within a particular tier can be determined by different placement heuristics than used for other tiers within a single response to a single request. (Specification, page 22, lines 21-24.)

Claim 49 further comprises inputting the tier criteria to define the number of tiers in the response and the number of listings within the tiers. For example, with regard to Appellants' Figures 1 and 2, the number of tiers 169, and the number of listings 104 within those tiers 169 are predefined in accordance with the administrative rules 122. For example, a response 144 could be configured to include six tiers 169 of three listings 104 each. (Specification, page 46, lines 26-29.)

Claim 49 further comprises configuring the administrative rules to generate a plurality of groups, wherein each said listing in said response is associated with at least one said group, each

said group being determined at least in part according to a request from a user. For example, a single response can include more than one group of listings. Listing groups can be dynamically defined by the interactions between listing attributes set forth by the provider, the request attributes set forth by the customer, and/or the administrative rules implemented by the administrator for the system. Each group in a response can have its own methodology for ordering the listings within the group. The listings need not be displayed in a manner that is determined in a sort by group. (Specification, page 12, line 30-page 13, line 2.)

O.   Claim 50

Claim 50 depends from claim 49. Claim 50 further comprises associating a particular type of placement heuristic to coincide with a particular type of request. For example, the placement heuristic 174 determines the placement and order of various listings 104. Any of the different attributes processed by the system 100 can be used by the placement heuristic 174 to arrange the display of the response 144. For example, in response to a national request, the placement heuristic 174 may be configured to give the best three spots to listings associated with the three highest fixed fee amounts 111, while providing spots four and five to the listings 104 associated with the top two per-hit fee amounts 113. In many embodiments, the placement heuristics 174 performed by the system 100 can be influenced by a priority metric 179 (discussed below). Alternative influences on the placement heuristic 174 can include but are not limited to affiliation with a particular group 232, fee types 112, geography attributes 108, category attributes 110, a date/time stamp, and/or a variety of different listing attributes 106 pertaining to a particular listing 104. The placement heuristic 174 can also be influenced by the administrative rules 122 and request attributes 134. (Specification, page 42, lines 6-19.)

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1.   Whether claims 1, 4-6, 10, 13, 14, 17, 18, 22, 23, 26, 27, 31, 36, and 48 are unpatentable under 35 USC § 103(a) over Soulanille in view of Bates.

2.   Whether claims 2 and 3 are unpatentable under 35 USC § 103(a) Soulanille and Bates further in view of Weidlich.

3.   Whether claims 28 and 29 are unpatentable under 35 USC § 103(a) over Soulanille and Bates further in view of Official Notice.

4.   Whether claim 30 is unpatentable under 35 USC § 103(a) over the combination of Soulanille and Bates further in view of Schena.

5.   Whether claim 33 is unpatentable under 35 USC § 103(a) over Soulanille and Bates, further in view of Mangold, and further in view of an article by Mahanta et. al entitled "BT dotcom."

6.   Whether claim 33 is unpatentable under 35 USC § 103(a) over Soulanille, Bates, and Acres further in view of Mahanta.

7.   Whether claims 34 and 35 are unpatentable under 35 USC § 103(a) over the combination of Soulanille and Bates further in view Acres.

8.   Whether claims 38-42 and 44-46 are unpatentable under 35 USC § 103(a) over Soulanille and the anonymous article "Google Comes Out Ahead," and further in view of Bates.

9.   Whether claims 49 and 52-56 are unpatentable under 35 USC § 103(a) over Soulanille in view of Watanabe and Bates.

10.　　Whether claim 50 is unpatentable under 35 USC § 103(a) over Soulanille, Watanabe, and Bates, and further in view of Official Notice.

VII. ARGUMENT

A.   The Law.

With respect to Section 103 rejections, the Examiner has a burden of stating a prima facie

case of obviousness. A prima facie case of obviousness has historically required that:

> First, there must be some suggestion or motivation, either in the
> references themselves or in the knowledge generally available to
> one of ordinary skill in the art, to modify the reference or to
> combine reference teachings. Second, there must be a reasonable
> expectation of success. Finally, the prior art reference (or
> references when combined) must teach or suggest all the claim
> limitations.

MPEP, § 2143 (citing In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

So long as the first requirement for a prima facie case of obviousness is not rigidly

applied, requiring the Examiner to show some reason for combining prior art references is

consistent with the United States Supreme Court's recent decision in KSR International Co. v.

Teleflex, Inc., 127 S.Ct. 1727, 82 USPQ2d 1385 (2007). In KSR, the Supreme Court stated that

"[t]he combination of familiar elements according to known methods is likely to be obvious

when it does no more than yield predictable results." (Id. at 1739, 82 USPQ2d at 1395.)

Additionally the court stated that

> It can be important to identify a reason that would have prompted a
> person of ordinary skill in the relevant field to combine the
> elements in the way the claimed new invention does. This is so
> because inventions in most, if not all, instances rely upon building
> blocks long since uncovered, and claimed discoveries almost of
> necessity will be combinations of what, in some sense, is already
> known.

(Id. at 1741, 82 USPQ2d at 1396.) The Court further explained that

> What matters is the objective reach of the claim. If the claim
> extends to what is obvious, it is invalid under §103. One of the
> ways in which a patent's subject matter can be proved obvious is
> by noting that there existed at the time of invention a known
> problem for which there was an obvious solution encompassed by
> the patent's claims.

(Id. at 1742, 82 USPQ2d at 1397.) Accordingly, the Court made clear that "a patent composed

of several elements is not proved obvious merely by demonstrating that each of its elements was,

independently, known in the prior art." (Id. at 1731, 82 USPQ2d at 1389.) In summary, KSR plainly does not disturb the well-settled proposition that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984); M.P.E.P § 2141.02.

B.   Ground Of Rejection No. 1: Claims 1, 4-6, 10, 13, 14, 17, 18, 22, 23, 26, 27, 31, 36, And 48 Are Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille And Bates.

1.   The Combination Of Soulanille And Bates Does Not Teach Or Suggest All Of The Elements Of Claims 1, 4-6, 10, 13, 14, 17, 18, 22, 23, 26, 27, 31, 36, And 48.

The combination of Soulanille and Bates fails to teach or suggest numerous elements of Appellants' claims. Accordingly, for any one of the independent reasons set forth below, the Examiner's rejections of Appellants' claims should be reversed.

Claim 1 is discussed in this section as an exemplary claim. The arguments presented herein also apply to independent claim 48 as well as all claims dependent from claims 1 and 48.

a.   "each said group being determined at least in part according to said request."

Independent claim 1 recites in part "each said group being determined at least in part according to said request." As admitted in the Final Office Action, Soulanille fails to disclose the foregoing recitation. (Final Office Action, page 3.) However, the Examiner asserted that Bates compensates for the acknowledged deficiencies of Soulanille. In fact, while Bates' disclosure does mention "dividing [search] results into multiple groups" (Bates, Abstract), Bates does not teach or suggest "each said group being determined at least in part according to said request."

In contrast to determining groups "at least in part according to said request," Bates teaches saving search parameters when a user performs an Internet search. Then, "if a subsequent related search is made, the search parameters are transferred to the internet search engine and [are] used to reorder or otherwise modify the search results." (Id.) Before search results are provided to a user,

the search engine re-orders search results by dividing the results
into multiple groups, including (in order of priority:[)] (a) those
URLs which are new since the last search; (b) those URLs which
have been previously visited [but] have changed . . . ; (c) those
URLs which existed before the previous search, but have not been
visited by the user; and (d) those URL's [sic] which the user has
previously visited and have not changed.

(Id.) In other words, Bates provides a pre-defined, static set of groups. The presence of a group

in Bates' search results is not in any way dependent on a user's search request, or on the

particular search results returned. Rather, Bates teaches obtaining a set of search results and then

putting each result into one of the pre-defined groups. Further, Bates' search results are

allocated to groups using stored parameters, not "according to said request."

Bates accordingly does not teach or suggest "each said group being determined at least in

part according to said request." As noted above, Bates' groups are pre-determined and do not

change regardless of the user's search request. Moreover, because Bates' groups are pre-

determined, one of ordinary skill would have thought it wholly unnecessary to have groups

"determined at least in part according to said request." Therefore, Bates not only fails to teach or

suggest "each said group being determined at least in part according to said request," but Bates

actually teaches against this recitation of claim 1.

For at least the foregoing reasons, the present rejection of claim 1, and all claims

dependent therefrom, should be reversed. For similar reasons, the present rejections of claim 48

and all claims dependent therefrom should also be reversed.

b.   Soulanille Could Not Have Been Combined With Bates.

Nothing in either reference would have made possible a combination of Soulanille with

Bates, particularly given how Soulanille is alleged by the Examiner to operate. The Examiner

asserted that Soulanille teaches that "said listings within said tier are ordered in accordance with

at least one of" the heuristics recited in claim 1. (Final Office Action, page 3.) However, Bates

teaches that its URLs and groups are sorted in order of priority. (Bates, column 11, lines 49-54.)

The Examiner gave no explanation as to how listings could be ordered within tiers according to

the heuristics recited in claim 1 and also according to groups. In fact, Appellants respectfully

submit that ordering listings according to the heuristics recited in claim 1 would preclude

ordering the listings according to the prioritized groups taught by Bates. Therefore, for the further reason that Soulanille and Bates could not have been combined, the present rejection of claim 1 should be reversed.

2.　　Claim 10 Is Separately Patentable.

Claim 10 depends from independent claim 1. Thus, claim 10 is patentable at least for the reasons discussed above with regard to claim 1. Moreover, claim 10 recites in part "said listings belonging to said tier belong to the same said group." In rejecting claim 10, the Examiner stated that "the listings belonging to the same tier could easily belong to the same group, if, for example, the highest priority group in Bates filled the tier, or the higher priority groups in Bates produced no results, leaving the tier to be filled by the lowest priority group." (Final Office Action, page 4.) Thus, the Examiner has plainly conceded that, assuming Soulanille and Bates could be combined, which they cannot, at a minimum many instances of search results returned by such combination would not include "said listings belonging to said tier belong to the same said group." Indeed, the Examiner contended that "said listings belonging to said tier belong to the same group" would be found in Bates for cases where Bates' priority groups would be rendered ineffective. Placement of all of the listings into one or the other priority group, for example the highest or lowest priority group, would, in effect, be the same as not using Bates' priority groups at all.

Further, imposing tiers on Bates' groups would interfere with the ordering taught by Bates. In an effort to bypass this inability to combine, the Examiner proposed special cases where "the highest priority group in Bates filled the tier, or the higher priority groups in Bates produced no results, leaving the tier to be filled by the lowest priority group," because admittedly, in many other cases tiers could easily re-order listings such that listings would no longer stay within Bates' pre-defined groups. (Final Office Action, Page 4.) To prevent such re-ordering, additional elements not taught or suggested by Bates or any of the other references would be required to ensure that "said listings belonging to said tier belong to the same said group." The Examiner has given no reason why an appropriate individual would have modified the proposed combination of Soulanille and Bates to ensure that "said listings belonging to said tier belong to the same said group," or provided a combination of references that would have

taught or suggested "said listings belonging to said tier belong to the same said group." Thus, Appellants respectfully submit that the proposed combination of Soulanille and Bates is insufficient to maintain the present rejection of claim 10.

Thus, for at least the foregoing reasons, claim 10 is separately patentable.

3.   Claim 17 Is Separately Patentable.

Claim 17 depends from independent claim 1. Thus, claim 17 is patentable at least for the reasons discussed above with regard to claim 1. Moreover, claim 17 recites "a plurality of responses, said plurality of responses including a first response and a second response, wherein said first response includes said tier and wherein said second response does not include said tier." The Examiner conceded that "Soulanille does not disclose a second response not including a tier of paid listings." (Final Office Action, page 4.) The Examiner did not cite any reference teaching or suggesting that "said second response does not include said tier," instead speculating that "in the case of someone requesting results on a search term for which no advertiser had bid, such a tier would be absent, and presumably only unpaid listings . . . would be displayed." (Id., pages 4-5.) Clearly, the Examiner cannot meet his burden of a prima facie case of obviousness by presuming that the prior art could include certain claim elements. Appellants respectfully submit that the Examiner's speculation is an insufficient basis on which to maintain the rejection of claim 17. For at least this reason, claim 17 is separately patentable.

4.   Claim 27 Is Separately Patentable.

Claim 27 depends from claim 26, which depends from claim 1. Thus claim 27 is patentable at least for the reasons discussed above with regard to claim 1. Moreover, claim 27 recites "[t]he system of claim 26, wherein said tier includes three said listings." The Examiner cited Figure 7 of Soulanille as allegedly disclosing these recitations. (Soulanille, Fig. 7.) In contrast to "wherein said tier includes three said listings" (emphasis added), Soulanille's Figure 7 merely discloses seven paid listings and two unpaid listings. (Soulanille, Fig. 7, col. 17 lines 8-15.) Indeed, Figure 7 does not contemplate tiers of a specified size, let alone tiers of three listings each, and in contrast merely discloses to show all the available paid listings, padded with unpaid listings to complete the screen. (Id.) Thus, for at least the foregoing reasons, claim 27 is separately patentable.

C.   Ground Of Rejection No. 2: Claims 2 And 3 Are Separately Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Bates, And Weidlich.

Claim 2 depends from claim 1, and claim 3 depends from claim 2. Claims 2 and 3 are therefore patentable for at least the reasons discussed above with regard to claim 1. Moreover, claim 2 recites, "a plurality of priority metrics, wherein said administrative subsystem uses at least some of said priority metrics to selectively identify said listings for inclusion in said tier." The Examiner admitted that Soulanille "does not expressly disclose that the administrative subsystem uses at least some (and more than one) of the priority metrics (together) to selectively identify the listings for inclusion in the tier." (Final Office Action, page 6.) The Examiner then cited Weidlich as allegedly curing the acknowledged deficiencies of Soulanille by stating, "Weidlich teaches using several priority metrics together to selectively identify listings for inclusion in a tier of search results (especially paragraph beginning, 'True search engines use software robots')." (Final Office Action, page 6.) In fact, Weidlich fails to teach or suggest the aforementioned claim recitations.

"A priority metric can be used by the placement heuristic to identify the desired order of various listings," where "the placement heuristic is a sub-process that is part of the response heuristic." (Specification, page 42, lines 5-27; Figure numbers omitted.) "The response heuristic is the process performed by the system to populate the response," and "[a] result heuristic is the process by which the results of a request are obtained." (Specification, page 40, lines 32-33; page 41, lines 18-19; Figure numbers omitted.) Further,

> the administrative subsystem impacts the functioning of the other subsystems because the administrative rules define how the request subsystem captures requests, how the result subsystem generates results from requests, and how the response subsystem generates responses from results.

(Specification, page 63, lines 22-26; Figure numbers omitted.)

In contrast, Weidlich discloses a spider crawling the Internet looking for web pages, which are then compiled to create indexes, wherein "[e]ach search engine uses a different algorithm to determine how relevant a Web page is to a user's query, assigning different weight to such factors as body text, links and meta tags." (Weidlich, paragraph beginning "it's important to understand".) Weidlich merely discloses that variations in the creation of indexes

of potential search results "will garner different results." (Id.) Although Weidlich may disclose using an algorithm to determine relevancy, this disclosure is insufficient to teach or suggest the aforementioned claim recitations at least because Weidlich lacks any teaching or suggestion of an "administrative subsystem" to impact the functioning of the other subsystems, let alone "wherein said administrative subsystem uses at least some of said priority metrics to selectively identify said listings" including subsystems that generate results from requests or responses from results.

Further, even if Weidlich teaches or suggests "a plurality of priority metrics, wherein said administrative subsystem uses at least some of said priority metrics to selectively identify said listings," which it does not, Weidlich still fails to teach or suggest, "a plurality of priority metrics wherein said administrative subsystem uses at least some of said priority metrics to selectively identify said listings for inclusion in said tier." (Emphasis added.) In contrast, as noted above Weidlich merely discloses presenting the user listings from an index for the corresponding search keywords. (Id.) Indeed, Weidlich fails to have any teaching or suggestion related to tiers at all.

For at least any of the foregoing reasons, claim 2, as well as claim 3 depending therefrom, are separately patentable.

D.   Ground Of Rejection No. 3: Claims 28 And 29 Are Separately Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Bates, And Official Notice.

Claim 28 depends from independent claim 1. Claim 29 depends from claim 28. Thus, claims 28 and 29 are patentable at least for the reasons discussed above with regard to claim 1. Moreover, claim 28 recites "a plurality of tiers, a plurality of responses, a plurality of requests, and a plurality of tier processing rules, wherein a number of said tiers and said tier processing rules differ for different said requests." The Examiner acknowledged that "Soulanille does not expressly disclose that the tier processing rules differ for different search requests." (Final Office Action, page 13.) However, the Examiner took Official Notice "that it is well known to apply different and known variations of a technique in different cases." (Id.) From this Official Notice, the Examiner concluded that the foregoing claim recitation would have been obvious "for such obvious advantages as testing to determine which rules worked best, or applying a set

of rules either specifically requested in a particular case, or believed to be most suitable to the circumstances." (Id.)

Without acquiescing to the Examiner's Official Notice, which Appellants timely traversed (Response After Final Action dated July 17, 2007, pages 16-17), Appellants respectfully submit that the purported prior art of applying "different known variations of a technique in different cases" does not in any way teach or suggest "a number of said tiers and said tier processing rules differ[ing] for different said requests." That is, the Examiner's Official Notice said no more than that it is known to conduct experimentation. However, the mere knowledge of experimentation by one of ordinary skill would not have suggested that "said tier processing rules differ for different said requests." Thus, this case is unlike those in which experimentation has been held to be obvious. *See, e.g., In re Boesch,* 617 F.2d 272, 276 (C.C.P.A. 1980) ("[D]iscovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art." (citations omitted)). Appellants' claim does not recite "apply[ing] different and known variations of a technique in different cases," but rather recites "a plurality of tier processing rules, wherein a number of said tiers and said tier processing rules differ for different said requests." There is no reason why knowledge of "apply[ing] different and known variations" would have in any way suggested an implemented system requiring that "said tier processing rules differ for different said requests."

For at least the foregoing reasons, claim 28 is separately patentable. Further, claim 29 is separately patentable at least by reason of its dependence from claim 28.

E.   Ground Of Rejection No. 4:   Claim 30 Is Separately Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Bates, And Schena.

Claim 30 depends from independent claim 1. Thus, claim 30 is patentable at least for the reasons discussed above with regard to claim 1. Moreover, claim 30 recites, "[t]he system of claim 1, further comprising a user location, wherein said system automatically includes said user location as part of said request." The Examiner admitted that "Soulanille does not disclose that the system automatically includes the user location as part of a request." (Final Office Action, page 14.) The Examiner contended that "it is well known to automatically include a user location as part of a search request, as taught by Schena (e.g., paragraphs 10, 11, 52, 53, and

54)." However, one of ordinary skill in the art would not have thought it possible to combine Schena with Soulanille, Bates or any other reference.

Schena teaches scanning print media from which machine-readable code is extracted and then combined with user information to be sent to a portal server via a network, where then a multimedia information sequence is sent to the receiver via the network. (Schena, Abstract.) Schena's "invention is related to bridging the gap between the virtual multimedia-based Internet works and the physical world of tangible object media." (Schena, page 1, lines 15-17.) Indeed, it is central to Schena to include print media with multimedia content, because without "tangible object media," Schena would be missing one of the two worlds Schena intends to bridge, and thus Schena could not be made to function. However, neither Soulanille nor Bates contains disclosure of "tangible object media," let alone scanners of such media, so there would be no way to combine Schena with Soulanille or Bates without fatally compromising the function of Schena. Mere disclosure of determining the scanner's location, without more, is insufficient to have resulted in a combination of these separate references, especially when the references are directed to unrelated systems, as is the case here. Therefore, for at least the foregoing reasons, claim 30 is separately patentable.

F.   Ground Of Rejection No. 5: Claim 33 Is Separately Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Bates, Mangold, And An Article By Mahanta et. al Entitled "BT dotcom."

Claim 33 depends from claim 32, which depends from claim 31, which depends from independent claim 1. Thus, claim 33 is patentable at least for the reasons discussed above with regard to claim 1. Moreover, claim 33 further recites "a number of hits and a period of time in which to measure said number of hits, wherein said number of hits in said period of time influence said variable per-hit fee." The Examiner conceded that none of the references applied to claim 32 (Soulanille, Bates, and Mangold) "disclosed that the number of hits in time in which to measure said number of hits influence a variable per-hit fee." (Final Office Action, page 15.) However, the Examiner contended that Mahanta compensated for the acknowledged deficiencies of the other cited prior art by allegedly disclosing "assuring the usefulness of a site by requiring a minimum number of impressions or click-through." (Id.) In fact, neither Mahanta nor any of the

other cited references disclosed that "said number of hits in said period of time influence said variable per-hit fee."

The portion of Mahanta cited by the Examiner merely discusses the right of an e-tailer to recognize revenues for click-throughs of banner advertisements:

> E-tailers are in for a reality check, too. Most dotcoms recognize revenue based on the value of goods sold online. ICIA says that won't do. Unless the ownership of the goods sold rests with the e-tailer, it can only recognize the commission it received from the transaction as its revenue. In the case of revenue from banners and other paid ads where the fee is contingent on a minimum number of impressions or click-throughs, the revenue should not be recognized until that promised level has been reached. Says the monograph: "The ad revenue should only be recognized when no significant obligations remain at the end of the period and collection of the resulting receivable is reasonable certain."

(Mahanta, paragraph beginning "E-tailers are in for a reality check, too.") This disclosure by Mahanta in no way teaches or suggests that "said number of hits in said period off time influence said a variable per-hit fee." In fact, Mahanta does not include teachings or suggestions that have anything to do with variable per-hit fees at all, but rather discusses accounting issues related to recognizing revenue from banner advertisements.

Further, the Examiner took Official Notice of the recitations of claim 33 in the Office Action of November 24, 2006, and was respectfully requested to provide support for such official notice in the Office Action Response of February 15, 2007. (See 37 CFR 1.104(d)(2) and MPEP § 2144.03, which states that "the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained.") However, in the Final Office Action, the Examiner failed to provide documentary evidence to disclose "said number of hits and said period of time influence said variable per-hit fee," instead citing the unrelated Mahanta reference. Therefore, the Examiner has stated insufficient basis for rejecting claim 33, and thus the rejection of claim 33 should be reversed at least for this reason.

Moreover, the Examiner's continued speculation that "it would have been obvious . . . for the number of hits or period of time to influence the variable per-hit fee, for such obvious advantages as charging more during times of the year when advertising is more in demand" is wholly unsupported by the prior art of record. Indeed, the Examiner's continued use of

30

unsupported Official Notice on this point only serves to reinforce the fact that none of the prior art references teach or suggest at least, "said number of hits and said period of time influence said variable per-hit fee," and therefore the rejection of claim 33 should be reversed at least for the foregoing reasons.

G.   Ground Of Rejection No. 6: Claim 33 Is Separately Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Bates, Acres, And Mahanta.

1.   Acres Cannot Be Combined With Soulanille Or Bates.

As stated above, claim 33 depends from claim 32, which depends from claim 31, which depends from independent claim 1. Thus, claim 33 is patentable at least for the reasons discussed above with regard to claim 1. Moreover, Claim 33 recites "[t]he system of claim 32, further comprising a number of hits and a period of time in which to measure said number of hits, wherein said number of hits and said period of time influence said variable per-hit fee." Although Acres was not cited as disclosing any specific elements of claim 33, Acres was cited as disclosing "variable per-hit fees (paragraph 6)" with regard to claim 32, from which claim 33 depends. However, one of ordinary skill in the art would not have thought it possible to combine Acres with Soulanille, Bates, or any other reference.

Acres discloses a system allowing users to play the game of reverse keno while visiting various websites. (Acres, Abstract.) Acres further discloses the mechanics by which the game of reverse keno is to be played. (Acres, Fig. 1, Fig. 8, paragraphs [0019]-[0026].) Acres is not directed to Internet search. In fact, Acres teaches away from providing listings based on search terms because Acres teaches and suggests displaying "appropriate" content based on collected personal information for the currently identified user, without user input apart from potentially a user login, whereas Internet search displays content based at least in part on search terms entered by the user. (Acres, paragraphs [0003]-[0007].) The structures of Soulanille and Bates require search terms from which listings are provided, but Acres lacks this necessary element. Indeed, Soulanille and Bates would be rendered inoperable by requiring the system to provide "appropriate" listings for a user without the user inputting search terms. For at least the foregoing reasons, Acres cannot be combined with Soulanille or Bates, and thus claim 33 is separately patentable.

2.   **Acres Fails To Teach Or Suggest Claim 33.**

Even assuming that Acres could have been combined with Soulanille and Bates, which it could not, the combination proposed by the Examiner still fails to teach or suggest each and every element of claim 33.

As stated above, claim 33 depends from claim 32, which depends from claim 31, which depends from independent claim 1. Thus, claim 33 is patentable at least for the reasons discussed above with regard to claim 1. Moreover, claim 33 further recites "a number of hits and a period of time in which to measure said number of hits, wherein said number of hits in said period of time influence said variable per-hit fee." The Examiner conceded that none of the references applied to claim 32 (Soulanille, Bates, and Acres) "disclose[d] that the number of hits and time in which to measure said number of hits influence a variable per-hit fee." (Final Office Action, page 16.) However, the Examiner again contended that Mahanta compensates for the knowledge to deficiencies of the other cited prior art by allegedly disclosing "assuring the usefulness of a site by requiring a minimum number of impressions or click-through." (Id., page 17.) Indeed, as discussed above, neither Mahanta nor any of the other cited references disclose that "said number of hits in said period of time influence said variable per-hit fee." Mahanta is directed to revenue recognition issues, and, is wholly irrelevant to the present claims. Thus for at least the aforementioned reasons with regard to the rejection of claim 33, claim 33 is also separately patentable over these references.

H.   **Ground Of Rejection No. 7: Claims 34 And 35 Are Separately Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Bates, And Acres.**

1.   **Claim 34 Is Separately Patentable.**

Claim 34 depends from claim 1. Thus, claim 34 is patentable at least for the reasons discussed above with regard to claims 1. As mentioned above with regard to claim 33, Acres cannot be combined with Soulanille and Bates, and even assuming that Acres can be combined with Soulanille and Bates, which it cannot, the combination still fails to teach or suggest all elements of claim 34.

Moreover, claim 34 recites, "[t]he system of claim 1, further comprising a plurality of per-hit fee types." The Examiner admitted that "Soulanille does not disclose a plurality of per-hit fee types." (Final Office Action, page 17.) The Examiner then contended that "a plurality of

per-hit fee types are well known, as taught, for example, by Acres (paragraphs 4, 5, and 6)."
(Id.) However Acres fails to teach or suggest at least "a plurality of per-hit fee types" as recited
by claim 34.

In contrast to "a plurality of per-hit fee types," Acres discloses other types of fees. Acres
states that "[a]n advertiser may pay a displaying web site that displays their advertisement a
certain amount each time that a user accesses a web page of the displaying web site that includes
the advertisement." (Acres, paragraph [0004].) Acres thus teaches a per-display fee, and not a
"per-hit fee type" as recited in Appellants' claims. At most, Acres discloses that "the advertiser
may pay the displaying web site an additional amount each time a user clicks through the
advertisement." (Id.) Therefore, Acres mentions at most one "per-hit fee type." Acres fails to
teach or suggest "a plurality of per-hit fee types," as recited in Appellants' claims. For at least
the foregoing reasons, claim 34 is separately patentable.

2.   Claim 35 Is Separately Patentable.

Claim 35 depends from claim 34, which depends from claim 1. Thus, claim 35 is
patentable at least for the reasons discussed above with regard to claims 1 and 34. Moreover,
claim 35 recites, "[t]he system of claim 34, wherein said plurality of listings includes a first
listing, wherein said first listing is associated with more than one said per-hit fee type." The
Examiner contended that Soulanille discloses a plurality of listings (Final Office Action, page
17), but the Examiner failed to point to any passage in Soulanille, Bates, Acres, or any other
reference that allegedly discloses the claim recitation that "said first listing is associated with
more than one said per-hit fee type." Instead, the Examiner opined without support that "it
would have been obvious to one of ordinary skill in the art of electronic commerce at the time of
applicant's invention for the first listing to be associated with the more than one per-hit fee type,
for the obvious advantage of profiting from different fee types." (Id.) However, at least because
there is no teaching or suggestion in any of the prior art for a system "wherein said first listing is
associated with more than one said per-hit fee type," the Examiner's speculation is wholly
unjustified, and is improper as a basis of rejection. Indeed, the Examiner's lack of support for
this point reinforces the fact that none of the prior art references teach or suggest at least,

"wherein said first listing is associated with more than one said per-hit fee type." Therefore, for at least the foregoing reasons claim 35 is separately patentable.

I.   Ground Of Rejection No. 8: Claims 38-42 And 44-46 Are Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, The Anonymous Article "Google Comes Out Ahead," And Bates.

Claim 38 recites in part "each said group being determined at least in part according to said request." Independent claim 38, as well as all claims depending therefrom, are patentable for at least the reasons discussed above with regard to claim 1. Moreover, there are additional reasons for the patentability of claims 38-42 and 44-46, discussed below.

1.   The Combination Of Soulanille, The Anonymous Article "Google Comes Out Ahead," And Bates Does Not Teach Or Suggest All Of The Elements Of Appellants' Claims.

Claim 38 recites in part that "said administrative rules provide for ordering said listings included in said response." The Examiner admitted that "Soulanille does not expressly disclose that the administrative rules also prioritize the listings within other tiers" (Final Office Action, page 19), and cited "Google Comes Out Ahead" as disclosing these recitations of claim 38. However, although "Google Comes Out Ahead" discloses that the Google search engine would "consistently rank the most useful and relevant sites as highest on the list" in a test of "five typical business research queries" (Google Comes Out Ahead, paragraphs 3 and 5), nowhere does the reference teach or suggest that "said administrative rules provide for ordering said listings included in said response," as recited in Appellants' claim 38. Instead, the article makes the conclusory statement that results returned by Google are "most useful and relevant," without any disclosure regarding "ordering said listings included in said response," let alone "said administrative rules provide for ordering said listings included in said response." Moreover, Bates is not cited for and fails to cure this deficiency of Soulanille.

Thus, for at least the aforementioned reasons, the alleged combination of Soulanille, the anonymous article "Google Comes Out Ahead," and Bates fails to teach or suggest at least this claim recitation of claim 38 and therefore the rejection of claim 38, as well as all claims depending therefrom, should be reversed.

2.   Claims 45 And 46 Are Separately Patentable.

Claim 45 depends from claim 40, which depends from independent claim 38. Claim 46 depends directly from independent claim 38. Thus, claims 45 and 46 are patentable at least for the reasons discussed above with regard to claim 38.

Moreover, claims 45 and 46 each recite independently patentable subject matter. Claim 45 recites in part:

> a first listing and a second listing, wherein a priority metric
> associated with said first listing is higher than a priority metric
> associated with said second listing, and wherein said second listing
> is given a more favorable placement than said first listing.

(Emphasis added.) Similarly, claim 46 recites in part:

> comprising a first listing and a second listing and a plurality of per-
> hit fees, wherein each said listing in said response is associated
> with at least one said per-hit fee, wherein said per-hit fee
> associated with said first listing is higher than said per-hit fee
> associated with said second listing, and wherein said second listing
> is given a more favorable placement than said first listing.

(Emphasis added.) In contrast to "said second listing is given a more favorable placement than said first listing" as recited in Appellants' claims, Soulanille instead discloses a scheme wherein listings are ordered using a weighted <u>random</u> scheme, and therefore Soulanille fails to teach or suggest at least these elements of claims 45 and 46. (Soulanille, col. 21, line 51 – col. 22, line 50.)

Soulanille's scheme unpredictably determines the order of the listings. In a random ordering listings of higher rank or priority could appear below those of lower rank or priority some of the time. However, that such an event is capable of occurring does not mean that Soulanille teaches or suggests that it occurs. Further, Soulanille's random scheme teaches away from the recitation "wherein said second listing is given a more favorable placement," because such "more favorable placement" would destroy Soulanille's random scheme.

Thus, for at least the foregoing reasons, claims 45 and 46 are separately patentable.

**J.   Ground Of Rejection No. 9: Claims 49 And 52-56 Are Patentable Under 35 USC §
         103(a) Over The Combination Of Soulanille, Watanabe, And Bates.**

Claim 49 recites in part "each said group being determined at least in part according to
said request." As mentioned above, claim 49, as well as all claims depending therefrom, are
patentable for at least the reasons discussed above with regard to claim 1. Moreover, there are
additional reasons for the patentability of claims 49 and 52-56, discussed below.

1.   Watanabe Cannot Be Combined With Soulanille Or Bates.

One of ordinary skill in the art would not have thought it possible to combine Watanabe
with Soulanille, Bates or any other reference. Watanabe teaches a system whereby a user
forwards a message to other users on his "buddy list," and upon receipt of the message, those
other users then forward the message on to yet others. (Watanabe, Abstract.) Thus, the system
of Watanabe "takes advantage of information-exchange relationships set up in instant messaging
systems," to send a message to "great numbers of persons." (Watanabe, paragraph 0011,
Abstract.) However, neither Soulanille nor Bates contain disclosure of lists of buddies or instant
messaging, and the Examiner gave no explanation as to how communication between buddies
could be incorporated with search listings in general, let alone with "inputting the tier criteria to
define the number of tiers in the response and the number of listings within the tiers" as required
by Appellant's claims. Mere disclosure of the inputting of data, without more, is insufficient to
support a combination of these separate references, especially when the references are directed to
unrelated systems, as is the case here. Therefore, for at least the reason that Watanabe cannot be
combined with Soulanille or Bates, the rejection of claim 49, as well as all claims dependent
therefrom, should be reversed.

**2.   The Combination of Soulanille, Watanabe, And Bates Does Not Teach Or
         Suggest All Of The Elements Of Appellants' Claims.**

Even assuming that Watanabe could have been combined with the other references,
which it could not, the combination of Soulanille, Watanabe, and Bates nonetheless fails to teach
or suggest elements of Appellants' claims.

Claim 49 recites in part, "inputting the tier criteria to define the number of tiers in the
response and the number of listings within the tiers." The Examiner acknowledged the failure of
Soulanille to disclose these claim recitations. (Final Office Action, page 24.) The Examiner

then cited Watanabe, without even addressing the specific claim recitation. In contrast to addressing the claim language, the Examiner merely asserted that "it is well known to input programs, files, and particular criteria into computers, as taught, for example, in Watanabe (paragraphs 57 and 58)." However, in contrast to any teaching or suggestion of "inputting the tier criteria to define the number of tiers in the response and the number of listings within the tiers," Watanabe instead simply discloses the "input of reception conditions that serve as judgment criteria for judging whether or not to receive the distribution information that the first computer distributes."

Although the "reception conditions" of Watanabe are input, they differ significantly from the recited "tier criteria" because the "reception conditions" are used for determining whether or not to receive data. Watanabe's "reception conditions" are not used for defining the format of data, let alone for "defin[ing] the number of tiers in the response and the number of listings within the tiers." For at least these reasons, the rejection of claim 49, as well as all claims dependent therefrom, should be reversed.

K.   Ground Of Rejection No. 10: Claim 50 Is Separately Patentable Under 35 USC § 103(a) Over The Combination Of Soulanille, Watanabe, Bates, And Official Notice.

Claim 50 depends from claim 49. Thus, claim 50 is patentable at least for the reasons discussed above with regard to claim 49. Moreover, claim 50 recites "[t]he method of claim 49, further comprising associating a particular type of placement heuristic to coincide with a particular type of request." The Examiner admitted that Soulanille "does not disclose associating a particular type of placement heuristic to coincide with a particular type of request." (Final Office Action, page 26.) The Examiner then took Official Notice, alleging that, "it would have been obvious … to associate a particular type of placement heuristic to coincide with a particular type of request, for the obvious advantage of placing listings likely to be of greater interest to the user, or value to advertisers, in more prominent positions." (Final Office Action, pages 26-27; Also see Office Action, page 25.) In the Office Action Response of February 15, 2006 (page 14), Appellants seasonably challenged the Official Notice taken by the Examiner, respectfully requesting the Examiner to provide support for the Official Notice. (Office Action Response of February 15, 2006, pages 13-14; See also 37 CFR 1.104(d)(2) and MPEP § 2144.03.)

However, in the Final Office Action, not only did Examiner fail to provide documentary evidence to support the Official Notice taken, but also incorrectly stated that Appellants did not traverse the Examiner's use of Official Notice. (Final Office Action, page 29.) As stated above, the Office Action Response of February 15, 2006, clearly traversed the Examiner's use of Official Notice with regard to claim 50 (page 14).

Moreover, the Examiner's continued speculation that "it would have been obvious … to associate a particular type of placement heuristic to coincide with a particular type of request, for the obvious advantage of placing listings likely to be of greater interest to the user, or value to advertisers, in more prominent positions" is wholly unsupported by the prior art of record. Indeed, Examiner's continued use of Official Notice on this point reinforces the fact that none of the prior art references teach or suggest at least, "associating a particular type of placement heuristic to coincide with a particular type of request." Thus, for at least the aforementioned reasons, claim 50 is separately patentable.

CONCLUSION

In view of the foregoing arguments, Appellants respectfully submits that the pending claims, including claims 1-56 at issue in this appeal, all recite statutory subject matter. The Examiner's rejection of claims 1-56 is improper because the claims recite machines and or method steps that achieve concrete, tangible, and useful results. In view of the above analysis, a reversal of the rejections of record is respectfully requested of this Honorable Board.

It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 18-0013, under Order No. 66703-0014, from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

Dated: November 2, 2007   Respectfully submitted,

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APPENDIX A – CLAIMS ON APPEAL

Pursuant to 37 CFR § 41.37(c)(vii), the following listing provides a copy of the claims involved in the appeal.

1.   An information distribution system, comprising:

a user subsystem, said user subsystem providing for a request from a user and a response, wherein said user subsystem provides for receiving said request and providing said response;

a listing subsystem, said listing subsystem providing for a plurality of listings, wherein at least a subset of said listings are included in said response;

a plurality of groups, wherein each said listing in said response is associated with at least one said group, each said group being determined at least in part according to said request; and

an administrative subsystem, said administrative subsystem providing for a tier, wherein said administrative subsystem selectively identifies two or more listings within said response for inclusion in said tier, wherein said listings within said tier are ordered in accordance with at least one of: (a) a random heuristic; (b) a weighted random heuristic; and (c) a placement heuristic not applied to all of the listings in said response.

2.   The system of claim 1, further comprising a plurality of priority metrics, wherein said administrative subsystem uses at least some of said priority metrics to selectively identify said listings for inclusion in said tier.

3.   The system of claim 2, further comprising a plurality of rankings, wherein said administrative subsystem uses said rankings to selectively identify said subset of listings for inclusion in said tier.

4.   The system of claim 1, further comprising a plurality of tiers.

5.   The system of claim 4, wherein said listings within each said tier are ordered in accordance with at least one of: (a) a random heuristic; (b) a weighted random heuristic; and (c) a placement heuristic.

6.   The system of claim 4, wherein each listing in said response is included in one of said plurality of tiers.

7.   The system of claim 1, further comprising a category selection, wherein said request includes said category selection, and wherein the selective identification of said subset of listings is influenced by said category selection.

8.   The system of claim 1, further comprising a geography selection, wherein said request includes said geography selection, and wherein the selective identification of said subset of listings is influenced by said geography selection.

9.   The system of claim 1, further comprising a geography selection, wherein the selective identification of said subset of listings is influenced by said geography selection.

10.   The system of claim 1, wherein said listings belonging to said tier belong to the same said group.

11.   The system of claim 1, further comprising a plurality of geography attributes and a plurality of category attributes, wherein each said listing in said response is associated with at least one said geography attribute and at least one said category attribute.

12.   The system of claim 11, wherein each said listing in said tier shares said geography attribute and wherein each said listing in said tier shares said category attribute.

13.   The system of claim 1, further comprising a plurality of payment type attributes, wherein each said listing in said response is associated with at least one payment type attribute.

14.   The system of claim 13, wherein each said listing in said tier shares said payment type attribute.

15.   The system of claim 1, further comprising a category selection and a category key word, wherein said request includes said category selection and said category key word, wherein said category selection and said category key word influence the selective identification of said subset of listings to be included in said response.

16.   The system of claim 1, further comprising a minimum bid amount and a plurality of per-hit fees, wherein all said listings within said tier are associated with per-hit fees that exceed said minimum bid amount.

17.   The system of claim 1, further comprising a plurality of responses, said plurality of responses including a first response and a second response, wherein said first response includes said tier and wherein said second response does not include said tier.

18.   The system of claim 17, further comprising a plurality of requests, said plurality of requests including a first request and a second request, wherein said first request causes the display of said first response, and wherein said second request causes the display of said second response.

19.   The system of claim 1, further comprising a plurality of responses, wherein only said listings associated with a national tier are included in said responses, said national tier including a first tier, a second tier, and a third, tier and a fourth tier, and said plurality of responses including a first response, a second response, and a third response.

20. The system of claim 1, further comprising an enhanced display format, wherein at least one said listing in said response includes said enhanced display format.

21. The system of claim 20, wherein said listing that includes said enhanced display format is included in said tier.

22. The system of claim 1, further comprising a position adjustment factor, wherein at least one said listing in said response includes said position adjustment factor.

23. The system of claim 22, wherein said listing that includes said position adjustment factor is included in said tier.

24. The system of claim 1, further comprising a minimum fee and a plurality of fees, wherein each said listing in said response is associated with at least one said fee, and wherein said fee for each said listing in said response exceeds said minimum fee.

25. The system of claim 1, further comprising a per-hit fee type, a minimum bid increment, and a plurality of per-hit fee values, wherein at least two listings in said response are associated with said per-hit fee type, wherein each said listing associated with said per-hit fee type is associated with at least one said per-hit fee value, and wherein all per-hit fee values are in accordance with said minimum bid increment.

26. The system of claim 1, further comprising a group of national sponsors sharing a common category and a plurality of tiers, wherein said response is comprised entirely of listings associated with said group of national sponsors sharing said common category.

27. The system of claim 26, wherein said tier includes three said listings.

28.   The system of claim 1, further comprising a plurality of tiers, a plurality of responses, a plurality of requests, and a plurality of tier processing rules, wherein a number of said tiers and said tier processing rules differ for different said requests.

29.   The system of claim 28, further comprising an administrator interface, wherein said administrator interface provides for modifying said tier processing rules.

30.   The system of claim 1, further comprising a user location, wherein said system automatically includes said user location as part of said request.

31.   The system of claim 1, further comprising a per-hit fee, wherein at least one listing in said response is associated with said per-hit fee.

32.   The system of claim 31, further comprising a variable per-hit fee, wherein said per-hit fee is said variable per-hit fee.

33.   The system of claim 32, further comprising a number of hits and a period of time in which to measure said number of hits, wherein said number of hits and said period of time influence said variable per-hit fee.

34.   The system of claim 1, further comprising a plurality of per-hit fee types.

35.   The system of claim 34, wherein said plurality of listings includes a first listing, wherein said first listing is associated with more than one said per-hit fee type.

36.   The system of claim 1, further comprising a category key word, wherein said request includes said category key word.

37.   The system of claim 36, further comprising a category selection, wherein said request also includes said category selection.

38.   A system for distributing information, comprising:

a depository of information, said depository of information including a plurality of listings; and

a server, said server including a request from a user, a response, and a plurality of administrative rules, said plurality of administrative rules including a plurality of placement heuristics;

wherein said server is configured to generate said response from said request by accessing said depository of information and said administrative rules;

wherein said administrative rules provide for ordering said listings included in said response;

wherein said administrative rules provide for identifying two or more listings in said response as belonging to a tier identified from a plurality of tiers; and

wherein said administrative rules prioritize said listings within said of tier using said plurality of placement heuristics;[1] and

wherein said administrative rules provide for generating a plurality of groups, wherein each said listing in said response is associated with at least one said group, each said group being determined at least in part according to said request.

39.   The system of claim 38, said plurality of tiers including a first tier and a second tier, said plurality of placement heuristics including a first placement heuristic and a second placement heuristic, wherein said first placement heuristic orders said listings within said first tier, wherein said second placement heuristic orders said listings within said second tier, and wherein said first placement heuristic is not identical to said second placement heuristic.

40.   The system of claim 38, further comprising a plurality of priority metrics, wherein each said listing in said response is associated with at least one of said priority metrics.

41.   The system of claim 40, wherein said priority metrics influence the administrative rules in selectively identifying listings for inclusion in said tier.

42.   The system of claim 41, wherein said listings are selectively identified for inclusion in said tier in accordance with said priority metrics.

43.   The system of claim 41, wherein the affiliations with said groups influence the administrative rules in selectively identifying listings for inclusion in said tier.

44.   The system of claim 40, further comprising a plurality of rankings, wherein each said listing in said response includes at least one said ranking, wherein said listings are ranked in accordance with said priority metrics, and wherein said administrative subsystem uses said rankings to selectively identify said listings for inclusion in said tier.

45.   The system of claim 40, further comprising a first listing and a second listing, wherein a priority metric associated with said first listing is higher than a priority metric associated with said second listing, and wherein said second listing is given a more favorable placement than said first listing.

46.   The system of claim 38, further comprising a first listing and a second listing and a plurality of per-hit fees, wherein each said listing in said response is associated with at least one said per-hit fee, wherein said per-hit fee associated with said first listing is higher than said per-hit fee associated with said second listing, and wherein said second listing is given a more favorable placement than said first listing.

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[1] When claim 38 was previously amended in the Office Action Response of November 24, 2006, the word "of" should have been removed the word in addition to only the word "plurality." This correction is being made here

47.   The system of claim 38, further comprising an enhanced display format and a position adjustment factor, wherein at least one said listing is associated with said enhanced display format and wherein at least one said listing is associated with said position adjustment factor.

48.   An information distribution system, comprising:

a user subsystem, said user subsystem providing for a request from a user and a response, wherein said user subsystem provides for receiving said request and providing said response;

a listing subsystem, said listing subsystem providing for a plurality of listings, wherein at least a subset of said listings are included in said response; and

an administrative subsystem, said administrative subsystem providing for a plurality of tiers, wherein said administrative subsystem selectively identifies two or more listings within said response for inclusion in one of said tiers, wherein said listings within said one of said tiers are ordered in accordance with at least one of: (a) a random heuristic; (b) a weighted random heuristic; and (c) a placement heuristic,

said administrative subsystem further providing for generating a plurality of groups, wherein each said listing in said response is associated with at least one said group, each said group being determined at least in part according to said request.

49.   A method for displaying a response to a request, comprising:

configuring a plurality of administrative rules to organize a plurality of listings within a response into at least one tier based on a plurality of tier criteria, wherein said administrative rules include a tier placement heuristic for ordering listings within the tier, wherein not all listings within the response belong to the tier;

inputting the tier criteria to define the number of tiers in the response and the number of listings within the tiers; and

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merely to correct this informality.

configuring the administrative rules to generate a plurality of groups, wherein each said listing in said response is associated with at least one said group, each said group being determined at least in part according to a request from a user.

50.   The method of claim 49, further comprising associating a particular type of placement heuristic to coincide with a particular type of request.

51.   The method of claim 49, wherein said system provides for a plurality of request types that includes at least two of: (a) a national request constrained by category; (b) a national request constrained by name; (c) a local request constrained by category; (d) a local request constrained by name; and (e) a phone number submission.

52.   The method of claim 49, further comprising loading a computer program on a server to automatically implement the administrative rules without human intervention.

53.   The method of claim 49, wherein said administrative rules include at least one priority metric calculation, and wherein said priority metric calculations influences the positioning of said listings in said response.

54.   The method of claim 53, wherein the listings are selectively placed into one of a plurality of tiers in accordance with the priority metric calculations associated with the listings.

55.   The method of claim 49, wherein the administrative rules provide that listings belonging to the same tier are ordered in a random fashion.

56.   The method of claim 49, wherein the administrative rules provide that listings belonging to the same tier are ordered in a random weighted fashion that is influenced by the corresponding priority metrics.

<u>APPENDIX B – EVIDENCE APPENDIX</u>

In this Appeal, Appellants do not rely on any evidence submitted pursuant to 37 CF.R.F. §§ 1.130, 1.131, or 1.132, or on any other evidence entered by the Examiner.

APPENDIX C – RELATED PROCEEDINGS APPENDIX

Not applicable – no related proceedings are referenced herein.